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EXAMINER
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MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

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05/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/312,150

Applicant(s)

MIRE, PHILIP J.

Examiner

Aravind K. Moorthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,7-12,18-22 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7-12,18-22 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to the arguments filed on 1 March 2007.
2. Claims 1, 7-12, 18-22 and 30 are pending in the application.
3. Claims 1, 7-12, 18-22 and 30 have been rejected.
4. Claims 2-6, 13-17 and 23-29 have been cancelled.

### ***Response to Arguments***

6. Applicant's arguments, see page 7, filed 1 March 2007, with respect to claims 1, 12 and 30 have been fully considered and are persuasive. The applicant has pointed out in figure 2 of the original specification both a "First User's Key Blob" 224 and a "Master Key Blob" 226 for both the first data processing system and the second data processing system. The rejection of the claims has been withdrawn.
7. Applicant's arguments filed 1 March 2007 have been fully considered but they are not persuasive.

On pages 7 and 8, the applicant argues that page 2 of the specification discloses that the cryptographic systems commonly use a given set of numbers or digits known as a cipher "key" that may be randomly chosen or have special mathematical properties. The applicant continues to argue that it is common in the art to generate session keys by random number or by other mathematical manipulation.

The examiner agrees that page 2 of the specification discloses that the cryptographic systems commonly use a given set of numbers or digits known as a cipher "key" that may be randomly chosen or have special mathematical properties. The examiner asserts that the independent claims recite three different types of keys (master, public and private). The cited

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portion of the specification does not specify which of the three keys is randomly chosen or have special mathematical properties. The applicant argues that it is common in the art to generate session keys by random number or by other mathematical manipulation. Again the examiner agrees that it is common in the art to generate session keys by a random number. However, the examiner asserts that it is also common in the art to generate session keys by passwords. There are multiple ways to generate a session key. So how is the examiner suppose to know the method of which the applicant is generating a session key. The examiner asserts that nowhere in the specification does it explicitly recite that a random number generates the session keys. Therefore, the examiner maintains the rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

On page 8, the applicant argues that the session key of Albanese is not used in conjunction with a symmetric encryption routine to encrypt data as required by independent claims 1, 12 and 30.

The examiner respectfully disagrees. Albanese discloses that messages are encrypted with a session's secret key [column 6, lines 31-33]. Albanese discloses that the key for encryption is the same key for decryption. That is the definition of a symmetric encryption routine.

On page 9, the applicant argues that Albanese, Dillaway and Kruys, alone, ore in combination, do not teach a method for encrypting data as claimed. The applicant argues that Dillaway teaches in the cited section [column 3, lines 24-31] a smart card that only holds a private key. The applicant argues that the smart card discussed on page 10, lines 10-19 of the

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present application “contains the user’s private keys and any public keys, as well as any other data that may be required by the systems with which smart card 134 is utilized”.

The examiner respectfully disagrees. As discussed above, Albanese discloses that messages are encrypted with a session’s secret key [column 6, lines 31-33]. Albanese discloses that the key for encryption is the same key for decryption. In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., contains the user’s private keys and any public keys, as well as any other data that may be required by the systems with which smart card is utilized) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On pages 9 and 10, the applicant argues that Kruys teaches in the cited section [column 2, lines 56-67] “public and private key pairs which share the same key value”. However, the plurality of private keys and the plurality of public keys claimed in claims 11 and 22 and described on pages 6 and 7 and throughout the present application do not have the same key value.

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the plurality of private keys and the plurality of public keys not having the same value) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 7-12, 18-22 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 12 and 30 recite "a session key randomly generated". However, after a careful review of the specification, the examiner finds no support in the original specification for a session key that was randomly generated.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**9. Claims 1, 7, 8, 12, 18, 19 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Albanese et al U.S. Patent No. 6,002,768.**

As to claim 1, Albanese et al discloses a method for encrypting data, the method comprising:

providing a first data processing system for a first user and a second data processing system for a second user [column 7, lines 7-28];

providing a session key randomly generated by the second system for use in encrypting original data [column 5, lines 14-30];

encrypting the data using the session key and a symmetric encryption routine [column 9, lines 37-43];

encrypting the session key, with a public key of the first user using an asymmetric encryption routine, for storage as a first user key blob [column 9, lines 37-43];

encrypting the session key, with a master public key using the asymmetric encryption routine, for storage as a master key blob [column 9, lines 37-43];

storing a first user private key on any media [column 4, lines 20-36];

decrypting the user key blob using the asymmetric encryption routine providing the first system with access to the session key [column 6, lines 31-44]; and

the first system decrypting the data using the symmetric encryption routine and securely transmitting the data to the first system [column 6, lines 31-44].

As to claims 7 and 18, Albanese et al discloses storing the first user's private key on a data storage medium coupled to the destination data processing system [column 8, lines 4-14].

As to claims 8 and 19, Albanese et al discloses storing the master private key on a data storage medium coupled to the destination data processing system [column 7, lines 7-28].

As to claim 12, Albanese et al discloses a method for encrypting data, the method comprising:

providing a first data processing system for a first user and a second data processing system for a second user [column 7, lines 7-28];

providing a session key randomly generated by the second system for use in encrypting original data [column 5, lines 14-30];

encrypting the data using the session key and a symmetric encryption routine [column 9, lines 37-43];

encrypting the session key, with a public key of the first user using an asymmetric encryption routine, for storage as a first user key blob [column 9, lines 37-43];

encrypting the session key, with a master public key using the asymmetric encryption routine, for storage as a master key blob [column 9, lines 37-43];



storing a first user private key on any media [column 4, lines 20-36];  
decrypting the user key blob using the asymmetric encryption routine  
providing the first system with access to the session key [column 6, lines 31-44];  
the first system decrypting the data using the symmetric encryption routine  
and securely transmitting the data to the first system [column 6, lines 31-44]; and  
a third party gaining access to the data using a master private key to  
decrypt the master key blob using the asymmetric encryption routine and gain  
access to the original data [column 9, lines 37-43].

As to claim 30, Albanese et al discloses a method for encrypting data, the method comprising:

providing a first data processing system for a first user and a second data  
processing system for a second user [column 7, lines 7-28];  
providing a session key randomly generated by the second system for use  
in encrypting original data [column 5, lines 14-30];  
encrypting the data using the session key and a symmetric encryption  
routine [column 9, lines 37-43];  
encrypting the session key, with a public key of the first user using an  
asymmetric encryption routine, for storage as a first user key blob [column 9,  
lines 37-43];  
encrypting the session key, with a master public key using the asymmetric  
encryption routine, for storage as a master key blob [column 9, lines 37-43];  
storing a first user private key on any media [column 4, lines 20-36];

decrypting the user key blob using the asymmetric encryption routine providing the first system with access to the session key [column 6, lines 31-44]; the first system decrypting the data using the symmetric encryption routine and securely transmitting the data to the first system [column 6, lines 31-44]; and a third party gaining access to the data using a master private key to decrypt the master key blob using the asymmetric encryption routine and gain access to the original data [column 9, lines 37-43].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claims 9, 10, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese et al U.S. Patent No. 6,002,768 as applied to claims 1 and 12 above, and further in view of Dillaway et al U.S. Patent No. 5,742,756.**

As to claims 9 and 20, Albanese et al does not teach retrieving the first user's private key from a smart card utilizing a smart card reader coupled to the destination data processing system.

Dillaway teaches private key stored on a smart card utilizing a smart card reader coupled to the destination data processing system [figure 2].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Albanese et al so that the first user's private key is

stored on a smart card coupled to the destination node. The private key is only retrieved when the smart card is inserted into the smart card reader.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Albanese et al by the teaching of Dillaway because it utilizes a smart card to perform critical cryptography operations. The smart Card can be programmed or otherwise configured to never expose the user's private keys. Rather than providing a private key to the user's computer, the key is held within the smart Card, and required cryptographic operations are performed on the smart Card itself. This makes it impossible for hostile code to obtain the private key [column 3, lines 24-31].

As to claims 10 and 21, Albanese et al does not teach retrieving the master private key from a smart card utilizing a smart card reader coupled to the destination data processing system.

Dillaway teaches private key stored on a smart card utilizing a smart card reader coupled to the destination data processing system [figure 2].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Albanese et al so that the master private key is stored on a smart card coupled to the destination node. The master private key is only retrieved when the smart card is inserted into the smart card reader.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Albanese et al by the teaching of Dillaway because it utilizes a smart card to perform critical cryptography operations. The smart card can be programmed or otherwise configured to never expose the user's private keys. Rather than providing a private key to the user's computer, the key is held within the smart card, and required

cryptographic operations are performed on the smart card itself. This makes it impossible for hostile code to obtain the private key [column 3, lines 24-31].

**11. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese et al U.S. Patent No. 6,002,768 as applied to claims 1 and 12 above, and further in view of Kruys U.S. Patent No. 5,555,309.**

As to claims 11, 22 and 29, Albanese et al does not teach utilizing a plurality of public master keys and a plurality of private master keys to decrypt the encrypted session key.

Kruys teaches a plurality of master keys [column 2, lines 56-67].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Albanese et al so that there would have been a plurality of public and private master keys to decrypt the encrypted session keys. There would have been multiple session keys so there would have been a public/private master key set to encrypt and decrypt the session keys.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Albanese et al by the teaching of Kruys because it utilizes master keys, each one of which is unique to a respective domain member, and is arranged to protect the respective member vector key of each domain member [column 3, lines 55-62].

***Conclusion***

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy *AM*  
May 1, 2007

  
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